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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,974	01/24/2006	Christian Hesse	I4219-093US1 P2003,0036 U	7920
26161	7590	01/29/2008	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			CHEN, KIN CHAN	
		ART UNIT	PAPER NUMBER	
		1792		
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		01/29/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/542,974	HESSE, CHRISTIAN
	Examiner Kin-Chan Chen	Art Unit 1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 November 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 and 9-11 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 9-11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimoto et al. (US 2002/0089065).

In a method for forming a device, Fujimoto discloses forming a first electrode and a second electrode on a base body; the first electrode at a location opposite the second electrode on the base body; chemically etching at least a portion of the base body to adjust the resistance of the base body to a predetermined value. See abstract, [0029] [0031], Figures 1A and 1B. Table 1.

Fujimoto teaches measuring the resistance of the base body before and after the chemical etch (for example, Table 1). The claimed invention differs from Fujimoto by specifying measuring the resistance of the base body during the etching (so-called while chemically etching the at least a portion of the base body in the claim). However, Fujimoto ([0041]) teaches that when a thermistor chip is dipped in the solvent, its

thermistor body becomes smaller as a whole during etching, causing the resistance value to increase...etc. With this principle in mind, it would have been obvious to one with ordinary skill in the art to measure the resistance of the base body during the etching process in order to check the progress of etching if needed. The examiner notes that in applicant's specification (page 4, last paragraph), the limitation related to "measuring the resistance of the base body during the etching" does not have any process steps and system clearly defined as to how the resistance is measured, therefore, there is no novelty or unobviousness is shown in applicant's specification.

***A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. In re Opprecht 12 USPQ 2d 1235, 1236 (CAFC 1989); In re Bode USPQ 12; In re Lamberti 192 USPQ 278; In re Bozek 163 USPQ 545, 549 (CCPA 1969).***

The limitations of claims 1, 10, and 11 have been addressed above and rejected for the same reasons, *supra*.

As to dependent claim 2, Fujimoto discloses that the base body comprises a ceramic material, see, for example, [0029].

As to dependent claim 3, see [0029] and [0045].

As to dependent claims 5 and 6, Fujimoto discloses immersing the base body in an etching liquid, such as sulfuric acid, see [0031].

As to dependent claim 7, see Table 1.

Fujimoto teaches that the portion of base body dissolved affects the resistance value [0031], Table 1. Claim 9 differs from Fujimoto by specifying various processing parameters (such as determine a difference between the predetermined valued and a measured value of the resistance and determining a duration for the etching). However,

same were known to be result-effective variables and commonly determined by routine experiment. The process of conducting routine experimentations so as to produce an expected result is obvious to one of ordinary skill in the art. In the absence of showing criticality or new, unexpected results, a person having ordinary skill in the art would have found it obvious to modify the prior art by performing routine experiments (by using different process parameters) to obtain optimal result with a reasonable expectation of success.

Dependant claim 4 differs from Fujimoto by specifying various sizes and dimensions (e.g., less than about 3 mm). Because same are merely a matter of choices of design depending on the product requirements and the disclosure of Fujimoto is not limited to any size of the base body, in absence of showing criticality or unexpected results, it would be obvious to one skilled in the art to use various dimensions in order to accommodate the specific product design and meet the product requirement.

### ***Response to Arguments***

3. Applicant's arguments filed November 9, 2007 have been fully considered but they are not persuasive.

Applicant has argued that Fujimoto fails to suggest measuring the resistance of the base body during the etching (so-called while chemically etching the at least a portion of the base body in the claim). It is not persuasive. As has been stated in the office action, Fujimoto ([0041]) teaches that when a thermistor chip is dipped in the

solvent, its thermistor body becomes smaller as a whole during etching, causing the resistance value to increase...etc.. With this principle in mind, it would have been obvious to one with ordinary skill in the art to measure the resistance of the base body during the etching process in order to check the progress of etching if needed. The examiner notes that in applicant's specification (page 4, last paragraph), the limitation related to "measuring the resistance of the base body during the etching" does not have any process steps and system clearly defined as to how the resistance is measured, therefore, there is no novelty or unobviousness is shown in applicant's specification.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the resistance is measured while etching, the etching process can be stopped as soon as the actual measured resistance of the base body has reached the target value) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### **Conclusion**

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kin-Chan Chen whose telephone number is (571) 272-1461. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 22, 2008

  
Kin-Chan Chen  
Primary Examiner  
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